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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,465	07/31/2000	Stacy Haitsuka	J1-98120B-US	5552

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EXAMINER
YOUNG, JOHN L

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/628,465	Applicant(s) Haitsuka et al.
	Examiner John Young	Art Unit 3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 31, 2000* .

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-27* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DRAWINGS

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §103(a)

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-27 are rejected under 35 U.S.C. §103(a) as being unpatentable over Merriman

5,948,061 (09/07/1999) (herein referred to as "Merriman") in view of Gerace 5,848,396 (12/08/1998) (herein referred to as "Gerace").

As per claim 1, Merriman (the ABSTRACT; FIG. 1; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) shows elements that suggest: "A method of providing an advertisement-related electronic presentation to a user of an online service, the user using a client application on a local device to access an online server associated with the online service, wherein the online service displays an advertisement to the user on behalf of a sponsor . . . the online server obtaining personal profile information from the user; the client application causing an advertisement to be displayed on the local device; the user performing a click-through on the advertisement; the client application transmitting a notification signal to the online server notifying the online server that the user clicked on the advertisement; the online server using the personal profile information to identify one or more resource locators according to a selection protocol associated with the advertisement; the online server transmitting a signal to the client application identifying the one or more resource locators; the client application causing the local device to access one or more resources associated with the one or more resource locators." Merriman lacks an explicit recitation of "wherein the online service displays an advertisement to the user on behalf of a sponsor. . . ." even though Merriman (FIG. 1; and col. 3, ll. 22-62) suggests same. In this case the Merriman's *"affiliate"* is interpreted as "a sponsor."

Gerace (FIG. 3B) discloses *"SPONSOR.."*

Gerace proposes sponsor modifications that would have applied to the method and system of Merriman. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Gerace with the teachings of Merriman because such combination would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

As per dependent claims 2-3, Merriman in view of Gerace shows the method of claim 1.

Merriman in view of Gerace lacks explicit recitation of the elements and limitations of claims 2-3, even though Merriman (the ABSTRACT; FIG. 1; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) in view of Gerace (the ABSTRACT; FIG. 3A; FIG. 3B; FIG. 3C; FIG. 3D; FIG. 3F; FIG. 3G; FIG. 4B; FIG. 5A; FIG. 5B; FIG. 5C; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-45; col. 13, ll. 1-67; and col. 15, ll. 1-67) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-3 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of

the invention to include the elements and limitations of claims 2-3, because such inclusion would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

As per claim 4, Merriman (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) shows elements that suggest: "A method of providing a sponsor access to data related to an advertisement that is displayed to a user of an online service administered by an online service provider, the user using a client application on a local device to access an online server associated with the online service, the local device including an input device and an output device, wherein the online service display[sic] the advertisement to the user on behalf of a sponsor . . . the client application activating; the client application causing the advertisement to be displayed on the output device; the user performing a click-through on the advertisement; the client application creating a data set, the data set including an identifier code associated with the advertisement and further including information descriptive of the user; the client application transmitting the data set to the online server via a communication channel from the local device to the online server; the online server storing the data set in a format that is accessible by the sponsor."

Merriman lacks an explicit recitation of "providing a sponsor access to data

related to an advertisement. . . ." even though Merriman (FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; and col. 3, ll. 22-62) suggests same. In this case the Merriman's *"affiliate"* is interpreted as "a sponsor."

Gerace (FIG. 3B) discloses *"SPONSOR. Interests."*

Gerace proposes sponsor modifications that would have applied to the method and system of Merriman. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Gerace with the teachings of Merriman because such combination would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

Merriman lacks an explicit recitation of "the client application creating a data set, the data set including an identifier code associated with the advertisement and further including information descriptive of the user. . . ." even though Merriman (FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; and col. 3, ll. 22-62) suggests same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Merriman (FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; and col. 3, ll. 22-62) would have been selected in accordance with "the client application creating a data set, the data set including an identifier code associated with the advertisement and further including information descriptive of the user. . . ." because such selection would have provided a means for *"targeting advertising."* (See Merriman

(col. 2, ll. 43-45)).

As per dependent claims 5-11, Merriman in view of Gerace shows the method of claim 4.

Merriman in view of Gerace lacks explicit recitation of the elements and limitations of claims 5-11, even though Merriman (the ABSTRACT; FIG. 1; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) in view of Gerace (the ABSTRACT; FIG. 3A; FIG. 3B; FIG. 3C; FIG. 3D; FIG. 3F; FIG. 3G; FIG. 4B; FIG. 5A; FIG. 5B; FIG. 5C; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-45; col. 13, ll. 1-67; and col. 15, ll. 1-67) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 5-11 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 5-11, because such inclusion would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

Independent claim 12 is rejected for substantially the same reasons as independent claim 1.

As per dependent claims 13-17, Merriman in view of Gerace shows the method of claim 12.

Merriman in view of Gerace lacks explicit recitation of the elements and limitations of claims 13-17, even though Merriman (the ABSTRACT; FIG. 1; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) in view of Gerace (the ABSTRACT; FIG. 3A; FIG. 3B; FIG. 3C; FIG. 3D; FIG. 3F; FIG. 3G; FIG. 4B; FIG. 5A; FIG. 5B; FIG. 5C; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-45; col. 13, ll. 1-67; and col. 15, ll. 1-67) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 13-17 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 13-17, because such inclusion would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

As per claim 18, Merriman (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) shows elements that suggest the elements and limitations of claim 18.

Merriman lacks an explicit recitation of the elements and limitations of claim 18, specifically, "marriage status" even though Merriman (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) suggests same.

Gerace (FIG. 3B) discloses *"Lifestyle . . . marital status. . . ."* elements.

Gerace proposes *"Lifestyle . . . marital status. . . ."* modifications that would have applied to the method and system of Merriman. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Gerace with the teachings of Merriman because such combination would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

As per dependent claims 19-23, Merriman in view of Gerace shows the method of claim 18 and subsequent base claims depending from claim 18.

Merriman in view of Gerace lacks explicit recitation of the elements and limitations of claims 19-23, even though Merriman (the ABSTRACT; FIG. 1; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) in view of Gerace (the ABSTRACT; FIG. 3A; FIG. 3B; FIG. 3C; FIG. 3D; FIG. 3F; FIG. 3G; FIG. 4B; FIG. 5A; FIG. 5B; FIG. 5C; col.

1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-45; col. 13, ll. 1-67; and col. 15, ll. 1-67) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 19-23 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 19-23, because such inclusion would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

As per claim 24, Merriman (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) shows elements that suggest the elements and limitations of claim 24.

Merriman lacks an explicit recitation of the elements and limitations of claim 24, specifically, "a message requesting the generic resource, wherein the message includes at least some of the user-specific information. . . ." even though Merriman (the ABSTRACT; FIG. 1; FIG. 2; FIG. 3A; FIG. 3B; FIG. 3C; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) suggests same.

Gerace (FIG. 3B) discloses *"Lifestyle . . . marital status. . . ."* elements.

Gerace proposes *"Lifestyle . . . marital status. . . ."* modifications that would have applied to the method and system of Merriman. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosure of Gerace with the teachings of Merriman because such combination would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

As per dependent claims 25-27, Merriman in view of Gerace shows the method of claim 24.

Merriman in view of Gerace lacks explicit recitation of the elements and limitations of claims 25-27, even though Merriman (the ABSTRACT; FIG. 1; col. 1, ll. 6-167; col. 2, ll. 1-45; col. 2, ll. 59-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-67; col. 8, ll. 1-67; col. 9, ll. 1-15) in view of Gerace (the ABSTRACT; FIG. 3A; FIG. 3B; FIG. 3C; FIG. 3D; FIG. 3F; FIG. 3G; FIG. 4B; FIG. 5A; FIG. 5B; FIG. 5C; col. 1, ll. 1-67; col. 2, ll. 1-67; col. 3, ll. 1-67; col. 4, ll. 1-67; col. 5, ll. 1-67; col. 6, ll. 1-67; col. 7, ll. 1-45; col. 13, ll. 1-67; and col. 15, ll. 1-67) suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 25-27 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 25-27, because such

inclusion would have provided a means for *"targeting advertising. . . ."* (see Merriman (col. 2, ll. 43-45)) and because such combination would have provided a means for *"targeted marketing. . . ."* (see Gerace (col. 2, ll. 30-35)).

CONCLUSION

3. Any response to this action should be mailed to:

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Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED PROCEDURE) or

(703) 746-7239 (for formal communications marked AFTER-FINAL) or

(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
Crystal Park V
2451 Crystal Drive
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The

examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

(Partial Signatory Authority)

Patent Examiner

January 30, 2003